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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,146	10/14/2004	Masami Kujirai	2004-1547A	1988
513 7590 12/04/2007 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER MOORE, MARGARET G	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 12/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/511,146	Applicant(s) KUJIRAI, MASAMI	
	Examiner Margaret G. Moore	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 7, 8, 10, 21 to 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 7, 8, 10, 21 to 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/13/07 has been entered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4, 7, 8, 10 and 21 to 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Scholz et al.

Scholz et al. teach a glass coating composition having anti-fogging properties. Particular attention is drawn to the working examples, such as Ex. 11, 12 and 13 (columns 25 to 28) in which a coating composition containing an epoxy silane in deionized water is prepared. The basis for this 102/103 rejection is consistent with that noted in the last two paragraphs of page 2 through the first two full paragraphs on page 3 of the office action dated 12/20/06. That is, while Scholz et al. fail to specifically teach the content of CaCO_3 it would appear that

the deionized water in Scholz et al. inherently meets this limitation and, if not inherently present, such a limitation would have been obvious over the teachings in Scholz et al.

Column 18, lines 35 and on, teaches glass substrates including motor vehicle windows and windshields. Column 19, lines 45 and on, teaches that only one side of the substrate can be coated with this composition.

While Scholz et al. fail to specifically teach the transparency limitation as claimed, this reference does teach that the composition is transparent and even that it improves transparency over an uncoated substrate (column 20, lines 11 and on). With the radiation heat absorptivity requirements, please note that products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. If applicants are of the position that the prior art does not, in fact, possess the same properties as the claimed composition, the claimed composition should be amended to distinguish itself from the prior art.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection. See MPEP 2112 (III).

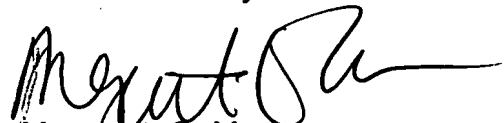
Since the CaCO_3 content claimed is either met by the deionized water in Scholz et al. or would have been obvious over the teachings of Scholz et al. and since the claimed characteristics of the coating will inherently be present in the composition of Scholz et al., the instant claims are anticipated and/or rendered obvious by the prior art.

For claim 7, see column 19, line 32. For claim 21, see column 15, line 63, which teaches amino silanes as a preferred silane. See also Example 43. For claim 22, see Examples 45, 46 and 48, which include a non-ionic surfactant

(termed wetting agent). Column 14 confirms that Triton X-100 is, in fact, a non-ionic surfactant.

For claims 10 and 25, in which the coated side of the glass faces away from the direction from which solar radiation heat is irradiated (e.g. for a windshield the coated side would face the driver or the inside of the car). Since the coating composition in Scholz et al. is intended to provide anti-fogging properties, the skilled artisan would recognize that when one side of a windshield is coated, it will be the inside since this is the side that fogs when driving. Note too that column 19, lines 60 and 61, indicate that the side facing the wearer should be coated if used as a face shield. Also column 20 refers to the coated substrate and human breathing, which would only be a factor when the coated side is facing the inside of a car.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.


Margaret G. Moore
Primary Examiner
Art Unit 1796

mgm
12/1/07